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Serial No.: 10/563,411
Atty. Docket No.: 500814.20119

REMARKS

The Examiner has rejected Claims 7-11 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner has also rejected Claims 7-11 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claim 7 stands currently amended. Claims 1-6 stand previously canceled. Claims 7-11 are currently pending. The following remarks are considered by applicant to overcome each of the Examiner's outstanding rejections to current Claims 7-11. An early Notice of Allowance is therefore requested.

I.   REJECTION OF CLAIMS 7-11 UNDER 35 U.S.C. § 112

On pages 2 and 3 of the current Office Action, the Examiner rejects Claims 7-11 under 35 U.S.C. § 112, first and second paragraphs. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Essentially, Examiner's rejection under both the first and the second paragraph of 35 U.S.C. § 112 are made because Examiner asserts that the units on the right side of the formula "$1 = 8 \times d \times 24 / WLF$" equate to "mm/(W/(m·K))" (i.e., millimeter / (watt / (meter × degree kelvin))) or "mm × m × K / W". However, the only value on the left side of the referenced formula is the length "l" of the beam spot, which must be a unit of length. As such, Examiner asserts that the formula does not make sense, as the units on the right side of the formula do not match those on the left side of the formula.

However, as explained above in relation to the amendments to the Abstract and Specification, there was an error in the translation of the International Application that was used to draft the Substitute Specification in the current Application. In particular, the description and the claims of the International Application PCT/DE04/01490 (published as WO 2005/002779) states "... wobei ... WLF der Betrag der Wärmeleitfähigheit ... ist ...." International Application, P. 12, Lns. 15-17; P. 14, Lns. 23-24. This phrase was incorrectly translated to "...

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WLF is the thermal conductivity ...." See Substitute Specification, ¶¶ [0027] and [0047] , Abstract; Preliminary Amendment, Claim 7. The correct translation reads: "WLF is the absolute value of the thermal conductivity".
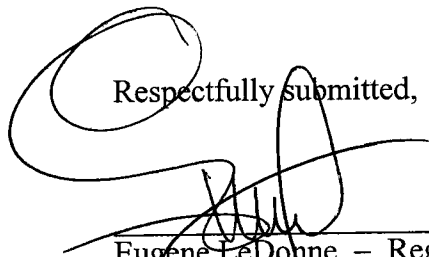
Accordingly, the Abstract, Specification, and Claim 7 were amended to correct this error. As such, in relation to the formula above, Claim 7 now states that "...WLF is the absolute value of the thermal conductivity of the ceramic to be split...." Since "WLF" is an absolute value, there is no unit of measurement associated with the "WLF" of the referenced formula. This means that the only unit of measurement on the right side of the referenced formula is that of the thickness "d" of the ceramic workpiece to be split, which is a must be a unit of length. This matches the unit of measurement on the left side of the, which, as discussed above, is also a unit of length.

Thus, Applicants respectfully assert that formula of Claim 7 is now both enabled and definite.

Accordingly, Applicants respectfully assert that independent Claim 7 is now in proper form, as are corresponding Claims 8-11 because they are ultimately dependant from independent Claim 7. Therefore, Applicants respectfully requests that Examiner withdraw the rejections of Claims 7-11 under 35 U.S.C. § 112, first and second paragraphs.

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Based upon the above remarks, Applicant respectfully requests reconsideration of this application and its early allowance. Should the Examiner feel that a telephone conference with Applicant's attorney would expedite the prosecution of this application, the Examiner is urged to contact him at the number indicated below.

Respectfully submitted,

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